



IN THE UNITED STATES PATENT OFFICE

Application Serial No. 07/838,675

Our File: PT-1039

Filed: February 21, 1992

Agent: Hughes, Etigson  
Suite 200  
175 Commerce Valley  
Drive, West  
Thornhill, Ontario  
L3T 7P6

Title: TREATMENT OF DISEASE EMPLOYING  
HYALURONIC ACID AND NSAIDS

Inventors: Rudolf Edgar Falk and  
Samuel Simon Asculai

Examiner: Dr. J. Krikorian

Art Unit: 1806

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**PETITION**  
**UNDER 37 C.F.R 1.181**

January 19, 1996

The Commissioner of Patents  
UNITED STATES PATENT OFFICE  
2011 Jefferson Davis Highway  
Crystal Plaza 2, Room 1B03  
Arlington, Virginia 22202  
U.S.A.

Dear Sir:

Petition is hereby made to the Commissioner of Patents under 37 C.F.R.  
1.181, (a) (3):

"To invoke the supervisory authority of the Commissioner in  
appropriate circumstances to withdraw the holding of abandonment  
dated December 22, 1995 of the above-identified application in view

of the following submissions and evidence and having regard (as a precedent dealing with the intention of the rules) to 37 C.F.R. 1.6 and 1.8 (b)."

### FACTS

An Official Action issued May 17, 1995 and was due for response August 17, 1995. Applicant prepared and delivered a "Response" to the Patent Office Mailroom on November 16, 1995. A copy of which "Response", as it was delivered, is attached as **Exhibit "A"** hereto. The "Response" included:

1. A "Reply" to the Official Action of May 17, 1995, including Schedules.
2. (a) A Request for a Three-Month Extension of Time to file the "Response" to the Office Action (together with the fee of \$900.00 U.S.) thus, giving Applicant until November 17, 1995 to file the "Response".  
  
(b) The extension fee comprised a cheque from Hughes, Etigson for \$900.00 U.S. drawn on the U.S. bank, "The Manhattan Bronx & Brooklyn Collection Arrangement at the Royal Bank of Canada, New York Branch".
3. Acknowledgment "Receipt" Card carrying sufficient U.S. postage returnable to Hughes, Etigson (the firm with which Ivor Hughes, Agent of Record is associated).

The above "Response" was put in a Federal Express envelope and delivered to the Patent Office on November 16, 1995 which is evidenced from the submissions and additional material enclosed.

On January 11, 1996, Hughes, Etigson received the Notice of Abandonment in respect of the above-identified file. A copy of the said Notice of Abandonment with the date-stamp of Hughes, Etigson as having been received January 11, 1996 is enclosed as **Exhibit "B"**. The said Notice of Abandonment carried a date of mailing of December 22, 1995.

Applicant's Attorney could not believe the Application had become abandoned in view of the fact that the "Response" had been timely filed by having been delivered by hand via Federal Express Courier from Hughes, Etigson's offices in Canada to the Patent Office on November 16, 1995. The reason for this conclusion is that Hughes, Etigson maintains a Federal Express "Tracking System" which is a computer system provided by Federal Express so that Hughes, Etigson may track and confirm the delivery of any package delivered by Federal Express on behalf of Hughes, Etigson. One of the packages to be delivered was in relation to this file. The "Tracking" system confirmed that the package had been delivered at 9:15 a.m. on November 16, 1995. The package had been signed for by "D. Jones". Now shown and marked as **Exhibit "C"** is a copy of the "Track System's Print-out" identifying the time of arrival of the package together with the signer's name at the Mailroom of the Patent Office to which the package was delivered. This "Tracking System Print-Out" was printed out of the computer database on November 16, 1995 (the date of delivery). The "Print-Out" bears the date November 16, 1995 on the top of the "Print-Out".

Attached as **Exhibit "D"** is a copy of the "Proof of Performance" which was signed for by "D. Jones" when the Federal Express package relating to this file was

received in the Mailroom by D. Jones. (This copy of the "Proof of Performance" was requested from Federal Express.) In fact, the Patent Office itself acknowledged receipt of the Federal Express package consisting of the "Proof of Performance" in its entirety because the "Acknowledgment Receipt" Card enclosed with the "Response" was returned by mail to Applicant's Agent. A copy of the front and back sides of this card is enclosed as **Exhibit "E"**. The date-stamp of the "Mailroom" at the Patent and Trademark Office is November 16, 1995. Therefore, in order for the Patent Office to have been able to return this "Acknowledgment Receipt" Card, it must have received the entire "Response" otherwise the recipient Patent Office would not have returned the "Acknowledgment Receipt" Card. The Commissioner should conclude, in granting of this Petition, that the facts and evidence herein are more conclusive of Receipt of the "Response" than the facts and evidence required under 37 C.F.R. 1.8(b). Thus, in keeping with the intention of 37 C.F.R. 1.8(b), to preserve the applications and their pending status, Applicant submits that one of the purposes of 37 C.F.R. 1.181 is to preserve pendency of the application not abandoned.

In view of the above submissions, Applicant respectfully requests that the Commissioner determine that the Application was never abandoned and therefore withdraw the holding of abandonment. The Commissioner is also requested to return the Application to Examiner Krikorian for continued prosecution.

### **DUE DILIGENCE**

When Applicant first received the Notice of Abandonment on January 11, 1996, Applicant attempted to contacted Examiner Krikorian to ask her to assist in trying to locate the "Response". The call was made on or about January 11, 1996 to Examiner Krikorian by Maria Giovannelli, Patent Administrator at Hughes,

Etigson. Ivor Hughes also called on January 12, 1996 to speak to Examiner Krikorian, but left a message on her voice mail (as she was not available). (Applicant believes this unavailability had to do with a winter blizzard that hit the Washington area.) In any event, Ivor Hughes reached Doctor Krikorian on January 17, 1996 and spoke with her. Dr. Krikorian asked if Mr. Hughes had the receipt card, and Mr. Hughes advised that he did. Dr. Krikorian also suggested to avoid this happening in the future, that Mr. Hughes when filing a response call and leave a voice mail message that a response is being filed in respect of a specific serial numbered application. Dr. Krikorian advised that there is a substantial backup in the mailroom.

Thereafter, Applicant's Agent prepared and filed this Petition and Declaration of Mr. Hughes.

There are, in Applicant's Attorney's submission, no fees required in view of the fact that the Application was never abandoned although the Patent Office may have forwarded the Notice of Abandonment. The Office is, therefore, respectfully requested to withdraw the Notice of Abandonment as the Application should never have been abandoned in the first place and find that the "Response" was timely filed.

In view of the above submissions, Applicant respectfully submits that the Application should now be returned to the Examiner for continued prosecution.

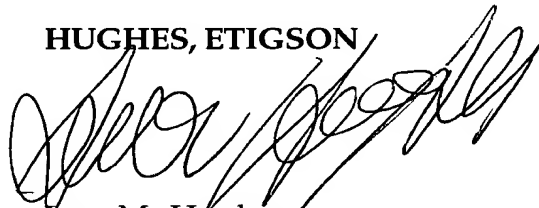
While Applicant's Agent has not enclosed any fees in respect of this Petition (as he believes there is none), if, however, the Patent Office determines that there should have been the payment of some fees, the Commissioner is respectfully requested to take the necessary fees from Deposit Account #08-3255 and advise Applicant's Attorney of the amount of the withdrawal and the file in

respect of which the withdrawal has been taken namely, Application Serial No. 07/838,675, Applicant's Agent's File No. PT-1039.

I, Ivor M. Hughes, Agent for Applicant, declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

**HUGHES, ETIGSON**



Ivor M. Hughes  
Agent for Applicant

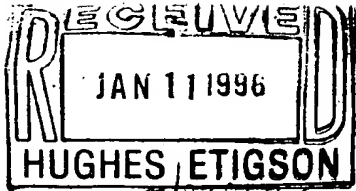
IMH/slh

**EXHIBIT "A"**

**See material attached at back.**

**EXHIBIT "B"**





**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/838,675	02/21/92	FALK	R FT-1039

MARCELO N. SARKIS  
175 COMMERCE VALLEY DRIVE, WEST  
STE. 200  
THORNHILL, ONTARIO, L3T 7P6 CANADA

13M2/1222

KRIKORIAN EXAMINER	
ART UNIT	PAPER NUMBER
1806	23

DATE MAILED:

12/22/95

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 5/17/95
- ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.
  - ☐ The issue fee was received on \_\_\_\_\_
  - ☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.

- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.
  - ☐ The corrected and/or substitute drawings were received on \_\_\_\_\_
- ☐ The reason(s) below.

*JK 12/21/95*  
JACQUELINE G. KRIKORIAN  
PATENT EXAMINER  
GROUP 1800

*1-173-308*  
*3964*

# **EXHIBIT "C"**

Tracking #: 400-415301P3

Service Type: PO

Activity	City	St	Date	Time
Delivered	ALEXANDRIA	VA	11/16	09:15
Package on Van	ALEXANDRIA	VA	11/16	08:23
Arrived at FedEx Dest Loc	ALEXANDRIA	VA	11/16	07:57
Package Arrived at FedEx Ramp	CHANTILLY	VA	11/16	05:34
Pkg Left FedEx Sort Facility	NEWARK	NJ	11/16	03:27
Int'l Pkg Manifest Created	DON MILLS	ON	11/15	20:22
Left FedEx Origin Location	DON MILLS	ON	11/15	19:53
Pickup Exception	DON MILLS	ON	11/15	17:33

Stat Exception: Pre-routed meter pkg picked up

Delivered to.: Mailroom

Delivery time.: 09:15

Signed for by.: D. JONES

\*\*\*\*\*CAUTION: DUPLICATE WAYBILLS EXIST FOR THIS SHIPMENT\*\*\*\*\*

PT-1039

filed  
Nov. 16/95

**EXHIBIT "D"**



DATE: January 12, 1996

MARIA  
9057716420

SUBJECT: PROOF OF PERFORMANCE

Dear MARIA:

This is in response to your request for proof of delivery for package tracking number 40041530193. You will find the delivery information below, but we are unable to provide a copy of the recipient's signature.

Tracking No: 40041530193

Ship Date: November 15, 1995

Shipper:

HUGHES ETIGSON  
175 COMMERCE VALLEY DR W #200  
THORNHILL, ON L3T7P6  
CA

Recipient:

COMMISSIONER OF  
UNITED STATES PATENT OFFICE  
2011 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202  
US

DELIVERY INFORMATION:

Signed for by: D JONES

Delivered to: 2011 JD HWY 1B03

Delivery Date: November 16, 1995

Delivery Time: 9:15 AM

We look forward to the opportunity of serving your future express shipping needs.

Sincerely,

Federal Express Corporation  
Worldwide Customer Service  
1-800-238-5355  
Reference No: 0112013327

3075 Airways Boulevard  
Memphis, TN 38115  
901 822-1650  
J.S. Mail Box 727  
Memphis, TN 38194-6643

**EXHIBIT "E"**

***FAX HEADER SHEET***

**FROM:** *Federal Express Corporation*

**PHONE:** *1-800-238-5355*

**TO:** **MARIA**

**PHONE:** **9057716420**

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Please acknowledge receipt of the following and return.

Document Enclosed please find the response to the office action dated May 17, 1995. Also enclosed is a Request for a three month extension of time with the fee of \$900.00 U.S.

<sup>Funds</sup> Dated November 15, 1995

Applicant / Client Rudolf E. Falk, Samuel S. Asculai

Your Reference 07/838,675 Our Reference PT-1039

Examiner \_\_\_\_\_ Group Unit / Class \_\_\_\_\_

Via Hand Delivery \_\_\_\_\_ Date \_\_\_\_\_

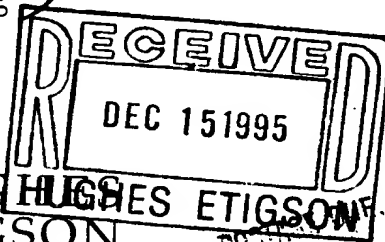
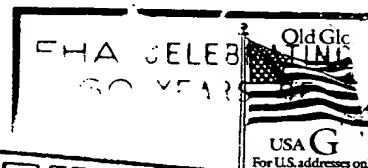
Courier Federal Express Date November 15, 1995

Serial No. \_\_\_\_\_

Received by \_\_\_\_\_ Date \_\_\_\_\_



AIR MAIL



HUGHES  
ETIGSON

Barristers & Solicitors

175 Commerce Valley Drive West  
Suite 200  
Thornhill, Ontario, Canada  
L3T 7P6